

REMARKS

This Request for Reconsideration is submitted in response to the Examiner's Action dated October 9, 2003 and pursuant to a telephonic conference between Applicant's representative and Examiner on December 17, 2003. During the telephonic conference, Applicant's representative explained why the features of the invention were sufficiently described, given what was generally known/understood by one skilled in the art at the time of the invention. Key statements from that discussion are presented below. Applicant respectfully requests Examiner reconsider the §132 objection and the §112 and §103 rejections, in light of the arguments provided below.

EXAMINER'S RESPONSE TO AMENDMENT

At paragraph 2 of the Office Action, Examiner objects to Applicant's amendment to the specification (Amendment A, filed on July 25, 2003) under 35 U.S.C. § 132. Specifically, Examiner states that the material added on page 17 is not supported by the original disclosure. Applicant respectfully disagrees with that assessment. As explained to Examiner during the telephonic conference, that specific section was copied almost verbatim from page 6, lines 11-18 of Applicant's originally filed disclosure. This sentence is clearly not new matter.

Notably, Applicant merely added the sentence to page 17 to provide a clearer understanding and/or explanation of implementation features questioned by Examiner in the §112 rejection. The sentence, when read within the context of the paragraph, provides a summary of how the client utilizes a "cookie response" functionality to provide the server with an indication that a prior issue of the publication has been opened. This sentence provides additional implementation details that enable one skilled in the art to practice the invention.

Since subject matter provided in the application when originally filed is not new matter, Applicant respectfully declines Examiner's request to cancel the amendment and respectfully requests Examiner remove the § 132 objection and enter the amendment.

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CLAIMS REJECTIONS UNDER 35 U.S.C. § 112

At paragraph 4 of the present Office Action, claims 1-21 are rejected under 35 U.S.C. § 112, first paragraph. The test for a valid §112, first paragraph, rejection is whether the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, has possession of the claimed invention. Applicant's specification, when read in the context of what was known in the relevant art at the time of the invention, does provide sufficient details to enable "one skilled in the relevant art" to practice the invention.

Examiner points to the following sections of the invention which Examiner believes are not sufficiently disclosed:

- (1) details of the electronic format of the issues. Examiner further states that "disclosure provides no guidance to one skilled in the art about the format of an issue"
- (2) how is a cookie [transmitted] with the issue (per amended claims); and
- (3) how does the client detect that an issue has been opened.

Each point raised by Examiner has been previously addressed in Amendment A. Applicant, therefore, incorporates by reference the arguments proffered in Amendment A, which clearly explain the sections of the Claims and Specification that provide a sufficient teaching for one skilled in the relevant art to practice the invention.

With respect to the latter two sections, Examiner states that "[s]uch questions would prevent one skilled in the art from implementing the applicant's invention ... without undue burden of experimentation..." Applicant disagrees with that assessment, and as was explained in the telephonic conference, Examiner is encouraged to consider the invention in light of several technologically available and implemented features known at the time of the invention.

At the time of Applicant's invention, "one skilled in the relevant art" would have been aware (or had knowledge) of the following:

- (1) electronic publication in "web page" format, whereby a server issues an html (or xml) document to a subscriber and the document is delivered to the subscriber's email inbox. The

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electronic publication is not an attachment but an actual document from the server that automatically displays the content of the publication when the email is clicked/opened by the subscriber;

(2) tracking of new (opened and unopened) email within an email engine, whereby the email engine monitors the "open" state of received emails and changes a display within the inbox (and/or messages a sender of the email) when the email is opened by the recipient. Most email engines (e.g., AOL®) provide some feature for determining when an email has been opened; and

(3) use of a "cookie" to return client-specific information to a server (i.e., in the present case, subscriber information).

Applicant's invention combines these known features into a publication-subscriber environment that controls when a push of an issue occurs from a publication server to a subscriber. That is, using the above known features, Applicant describes associating a cookie with an issue, which is understood by one skilled in the relevant art (Internet communication tracking feature) to involve providing "cookie" functionality within (or associated with or tagged to) the publication's (web page) source code. The cookie feature enables a return function, similar to standard cookies that return client-specific information. The content of the cookie is changed/updated when an email issue within the email engine has been opened. Applicant described the return-to-server function of the cookie as a "cookie response" that provides an indication to the publication server of whether the emailed publication was opened by the subscriber's email engine.

Specific sections of Applicant's specification describes the functionality provided by the above features, which have been harnessed and extended and then combined with novel functions to create Applicant's claimed invention.

On page 2, lines 7-11, Applicant discusses electronic format of THE WALL STREET JOURNAL, which is one type of electronic publication addressed by Applicant's invention. At page 17, line 4-21, Applicant states that the issue is viewed utilizing a web browser, and Applicant further refers to the issue as a web page. At the time of Applicant's invention, the format required for delivery of a publication via email that opens up as a web page within a

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browser would have been known to one skilled in the art. Most of these techniques were available and known even in the context of push techniques for delivering electronic content (via email, etc.) to subscribers (see page 4).

Associating a cookie with a downloaded web page (i.e., an html or xml document having functional source code and content) is well known in the art. The methods for including cookie functionality within the html document or a link to such functionality (perhaps in another html file) are known to those skilled in the computer (or Internet communication) arts. Notably, Applicant utilizes the term "cookie" primarily to harness the return-to-server functionality (provided by a cookie) that enables the server to track when an issue is opened. Page 6, lines 12-18 describes the push engine transmitting an HTTP cookie along with the issue and using a cookie response from the subscriber to know when the issue has been opened.

Notably, also, the possible 112 rejection of the cookie feature applies to only one of two implementations (and only 3 of 21 claims) of Applicant's invention by which the "open" status of the received issue is monitored and messaged to the server. The second implementation utilizes a status request and status response (see, for example, Claims 7, 14, 21 and 10,13, etc.).

On page 16, lines 22-page 17, line 3, Applicant carefully outlines the utilization of a client program (e.g., email engine) that carries out the functional features of: receiving the issue; saving the issue; determining whether the saved copy has been opened; and transmitting a status update to the server. Again, even one with limited skill in the computer arts would be aware that it is very possible to track when a received email is opened on a client system. Most client systems (i.e., engines) track "open" status of incoming emails and changes the display of the received email when it is opened. Since the capability of tracking when an email is opened is available, Applicant simply harnessed this functionality and extended it to the specific implementation provided by Applicant's invention.

Examiner's rejections are based on the assumption that "one skilled in the relevant art" is not familiar with the above-described features for basic email engine operation, cookie response functionality, and electronic publication. Based on Applicant's knowledge of the art, anyone

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holding himself out as skilled in the art would have been aware of how these individual features work. The answers to the questions raised by Examiner can be clearly determined after reading Applicant's specification.

However, the specific method of extending these features and combining them to provide the novel functional features of Applicant's invention would clearly have not been known absent Applicant's specification. That is, the combination of the above features do not of themselves teach or suggest specific features of the invention, such as tracking when a publication issue is opened by the engine and sending a next issue only after the first issue has been opened.

Finally, while Applicant could have provided an extensive discussion of each of these well-known features, Applicant necessarily assumed that one skilled in the relevant art would not require such a teaching. Applicant focused his specification on a description of how to provide specific novel features given what was available knowledge to those skilled in the art. Any other approach to drafting the specification would require a level of detail that would make the patent application unnecessarily lengthy and including superfluous descriptions of features not directly relevant to the Applicant's invention.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

At paragraph 6 of the Office Action, Claims 1-3, 7-10 and 14-17 are rejected under 35 U.S.C. § 103(a), as being unpatentable over Griebenow, et al. (U.S. Patent No. 5,850,520).

At paragraph 14 of the Office Action, Claims 5-6, 12-13 and 19-21 are rejected under 35 U.S.C. § 103(a), as being unpatentable over Griebenow, et al. (U.S. Patent No. 5,850,520) in view of Hoyle (U.S. Patent No. 6,141,010).

Neither Griebenow nor the combination of Griebenow suggest to one of ordinary skill in the art the features provided by Applicant's claimed invention. Applicant again incorporates by reference the arguments provided in Amendment A, which Applicant believes overcomes the present rejections.

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Each independent claim of Applicant's claimed invention recites: "electronically transmitting a second issue of said serial electronic publication to said subscriber only after determining that said first issue has been opened" (emphasis added). Griebenow (and the combination of Griebenow and Hoyle) does not render Applicant's invention unpatentable because Griebenow (and the combination) does not suggest this key feature of Applicant's invention. In his statement at the end of numbered paragraph 5 of the Action, Examiner initially appears to recognize that Griebenow does not teach or suggest this feature. Examiner, however later states that col. 10, lines 30-48 suggests this feature.

Col. 10, lines 30-48 is completely devoid of any reference or suggestion of this feature of Applicant's claimed invention. Rather, that section discusses the manner of displaying advertising on pages of the electronic publication, which includes a timed display of the advertisement (e.g., every 15 minutes that the user reads the application). The section further states that "[t]he advertising timing carries over to the next time... prevent a consumer from trying to avoid viewing advertising." Even col. 9, lines 5-11 only describes customizing a publication and/or the advertisement within a publication. Nowhere in Griebenow is there any reference or suggestion of preventing a push of a next issue of a publication until after the first (or previous) issue has been read. The advertisement opens automatically on the consumer's device and is displayed regardless of whether or not the consumer reads the previous advertisement or takes any action that may be considered opening the advertisement.

Col. 8, lines 19-56 does not teach several of the features that Examiner indicates is taught therein. For example, column 8, lines 33-56 does not teach or suggest a status manager determine whether the first (publication) issue has been opened by a subscriber. That section describes a timing engine that determines "whether it is time to send a renewal notice to the consumer because the consumer's subscription ... has lapsed or is about to lapse." The timing engine sends a message/notice (i.e., an item functionally different from the publication) with a return receipt requested to provide electronic verification of the receipt of the message/notice. There is no condition on delivering a second issue based on opening of a first issue. In fact, Griebenow's timing engine keeps sending the next publication out until the subscription lapses, regardless of whether or not the subscriber reads the previous issues.

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Hoyle also fails to teach or suggest this feature. Further, the cited section of Hoyle (col. 17, line 27-45), relied upon as suggesting dependent claim features, does not teach specific use of a cookie to provide status message about whether an issue has been opened on a client system. That section of Hoyle describes including a user ID in a cookie placed on the user's computer, where the user ID is "stored along with demographic data to identify the user for the purpose of demographically targeting advertising to that user."

It is clear that key features of Applicant's invention are neither taught nor suggested by any of the above references or combination of references. For these reasons, one skilled in the art would not find Applicant's invention obvious in light of the references and combinations thereof. Applicant's claims are therefore allowable.

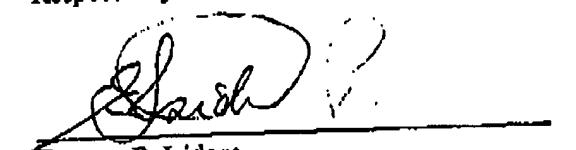
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CONCLUSION

Applicant has diligently responded to the Office Action by clearly explaining the features recited within the specification that would enable one skilled in the relevant art to practice the invention without undue experimentation. Applicant has further explained why the claims are not obvious over the references or combination of references. The arguments overcome the §§ 132, 112 and 103 rejections, and Applicant, therefore, respectfully requests reconsideration of the rejections and issuance of a Notice of Allowance for all claims now pending.

Applicant respectfully requests the Examiner contact the undersigned attorney of record at (512) 542-2130 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,



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